



9-19-02

AF
2800

13/Recons.
NE
P. Walker
9-24-02

RECEIVED
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

SEP 23 2002

Attorney Docket: NLN.301 (NLSN.1000B)

Mark Nelson *et al.*

TECHNOLOGY CENTER 2800

September 18, 2002

Serial No.: 09/810,084

Group #: 2859

Filed: March 16, 2001

Examiner: Mirellys Jagan

For: Linear Measurement Workpiece Gripping Device

Box AF
Commissioner for Patents
Washington, D.C. 20231

Sir:

REQUEST FOR RECONSIDERATION AFTER FINAL OFFICE ACTION

Responsive to the Final Office Action dated July 8, 2002, Applicants submit the following remarks:

At the outset, Applicants wish to thank the Examiner for the courtesy of the telephone interview conducted on August 28, 2002 between the Examiner and one of the attorneys of record, Jon M. Dickinson. During that telephone conversation, Applicants' representative pointed out to the Examiner an important and prominent distinguishing aspect of the cited and applied Hoffman reference - an aspect which Applicants urge makes that reference functionally uncombineable with the Richardson reference in a rejection of Applicants' claims.

At the conclusion of the telephone conversation, the Examiner suggested that Applicants file this Request for Reconsideration After Final Office Action, summarizing the points raised regarding Hoffman. The Examiner further suggested that Applicants indicate what changes

in the claims might be made to make clearer the difference between Applicants' claimed invention and the content of Hoffman. Specifically, the Examiner asked that this Request not actually propose any amendments to claim language, but rather that it contain an indication of what, if any, kind of claim language change Applicants might propose, and which might be mutually agreeable both to Applicants, and to the Examiner. Accordingly, this document contains a summary, as requested, of the distinguishing subject matter discussed in the interview with the Examiner, and additionally includes a portion which identifies proposed language changes in certain ones of the current claims.

Focussing attention first of all on the deficiencies of Hoffman, the Hoffman patent disclosure is clearly, and very pointedly, expressive about the fact that the device pictured in this patent, in all of its variations, be a device which is substantially entirely planar, and anchorable to the outer reference end of a tape in a manner whereby one of the device's faces will lie substantially precisely at the outer reference end of the tape. This enables accurate measurement to be keyed effectively off of this face, and very specifically, off of this face which lies in face-to-face contact with the end of a workpiece being measured. The importance of this many-times expressed concern and consideration, is emphasized by the fact that it is wide spread throughout the specification and the claims in the Hoffman patent. All of the Hoffman modifications, with regard to having a structure containing a flat planar face that positions itself exactly at the outer reference end of a tape, are identical. While the perimeter outlines of these various modifications differ, there is no difference, from modification to modification, in there being a structure having a flat planar face which defines a reference measuring plane that lies

unoccluded, and exactly at the reference outer end of a measuring tape. For example, different manners of expressing Hoffman's significant concern for this structural aspect of his invention appear in the Abstract at lines 5 and 6, and at numerous locations throughout the specifications such as: Column 1, Lines 16 and 17, Column 1, Lines 24 and 25, Column 1, Lines 32 and 33, Column 2, Lines 8 and 9, Column 2, Lines 26, 27 and 28, Column 2, the last line thereof and continuing to the first two lines in column 3, Column 4, Lines 17, 18 and 19, Column 4, Lines 31 and 32, Column 5, Lines 6 - 9, inclusive, Column 5 Lines 24 - 27, inclusive, Column 5, lines 41 - 48, inclusive, Column 5, Lines 54 and 55, Column 5, Lines 64 and 65, Column 6, Line 1, Column 6, Line 5, Column 6, Line 11, Column 6, Line 18, and Column 6, Line 21.

It is very plain that this extensive focus on the importance of positioning of a measuring surface effectively exactly at the measuring outer reference end of an extensible tape is what clearly sets the teachings of the Hoffman patent in a distant field relative to Applicants' claimed invention.

Anchoring the importance to Hoffman of having an attachable device provide a planar reference surface exactly at the outer reference end of a tape is the very significant and direct warning which is given in Claim 1, Column 8, in the 5th and 4th lines up from the last line in this claim. Here, in Claim 1, Hoffman specifically states that in his device there are to be "no tab portions extending beyond said transverse tab portions". Hoffman thus gives a bold and very plain warning that the device of his invention, as is pictured in every embodiment shown and discussed in his patent, not have any extension which would interfere with there being a flat and planar end that defines a measurement reference plane at the end of an extension tape. The warning against

extensions has no practical meaning except with respect to an extension which, with a Hoffman device in place, might extend toward and into the "measuring region" of a tape. Further lateral extensions, or extensions longitudinally away from a tape end, would deserve no warning whatsoever, but an extension into the measurement area definitively would merit a warning in relation to Hoffman's teachings.

By way of contrast, Applicants' invention is one wherein, with their device attached to the end of a measuring tape, the tooth-like projections therein, which extend around the perimetral edge of the circular body of Applicants' device, definitively extend exactly in the direction that Hoffman warns against. In fact, if Applicants' tooth-like projections did not extend beyond the plane of attachment at the outer end of an associated tape, they would have no function whatsoever in gripping successfully the end of a workpiece. Put another way, Applicants' invention requires that projecting teeth will engage the workpiece, and thus effectively hold the facing planar central body of the device securely near the end of a workpiece. In other words, Applicants' invention cannot function in the way that Hoffman's device does.

With regard to this warning against a certain kind of extension, rather than placing this warning in some fashion within the body of the Hoffman specification, Hoffman felt concerned enough about it to include it as a major limitation in the broadest allowed claim, which limitation makes its way into each and every other one of the four additional patented claims in the Hoffman reference.

A merger of Hoffman and Richardson, as is proposed by the Examiner, would fly defiantly right in the face of this warning.

With regard to Applicants' claims herein, Applicants suggest that additional language be inserted into the texts of claims 1, 12, and 13, the three independent claims in this case, which language will further define the projecting configurations of the surface-gripping projection elements that are now recited in these claims. Very specifically, Applicants suggest the insertion of the following phrase, immediately after the recitations of surface-gripping projection elements : -- which project from the plane of the body expanse toward the direction of a joined measuring tape --. In each of the three independent claims mentioned, this kind of a further statement might have to be worked into the claim in slightly different formats in order to maintain good readability of the claim, but fundamentally, this expression of projection is definitively an expression of a projection which is forcefully warned against in Hoffman's claim 1.

For all of these reasons, Applicants submit that a change in the three independent claims along the lines suggested herein will clearly identify a key difference between Applicants' claimed invention and any proper contribution that might be proposed in a rejection employing a combination of the Hoffman and Richardson references. To make the combination with Hoffman that is proposed by the Examiner, a change would have to be made in the Hoffman structure which would introduce a projection which is expressly forbidden by the language set forth in Hoffman claim 1.

Accordingly, favorable review and reconsideration of the Examiner's position respecting patentability of Applicants' claims are respectfully solicited. Applicants' attorneys invite a call from the Examiner should receipt and study of this document raise questions that the Examiner would like to discuss in a telephone conversation. With respect to such a conversation,

the Examiner is specifically invited to call Jon Dickinson at the following phone number:
503-504-2271.

Accompanying this Request is a Revocation and Appointment of Power of Attorney and Change of Correspondence Address, appointing the undersigned and Jon M. Dickinson as Applicants' Attorney and changing the correspondence address for this Application.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any over-payment to Account No. 22-0258.

Customer Number

Respectfully Submitted,

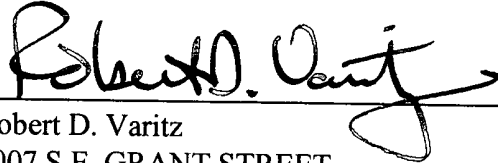


ROBERT D. VARITZ, P.C.

23855

PATENT TRADEMARK OFFICE

Registration No: 31436
Telephone: 503-720-1983
Facsimile: 503-233-7730


Robert D. Varitz
2007 S.E. GRANT STREET
Portland, Oregon 97214